

REMARKS

This paper is presented in response to the Office Action. By this paper, claims 1-12 are cancelled, claims 13 and 14 are amended, and new claims 24-29 are added. Claims 13-29 are now pending in view of the aforementioned cancellations and new claims.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the convenience and reference of the Examiner, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicant notes that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, and amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner, and/or the merits of additional or alternative arguments.

II. Rejection of Claims 1-3, 10, 13-14, 20 and 22 under 35 U.S.C. § 102(e)

The Examiner has rejected claims 1-3, 10, 13-14, 20 and 22 under 35 U.S.C. § 102(e) as being anticipated by US 6,807,131 to Hesselink et al. ("*Hesselink*"). In view of the cancellation herein of claims 1-12, Applicant submits that the rejection of claims 1-3 and 10 has been rendered moot and should accordingly be withdrawn. As to the remaining claims 13-14, 20 and 22, Applicant disagrees with the Examiner and submits that for at least the reasons outlined herein, the rejection of those claims should be withdrawn.

By this paper, Applicant has amended independent claim 13 to recite "... where formation of the at least one optoelectronic structure comprises depositing an epitaxial layer on a substrate [and] ... said isolation moat extends into the epitaxial layer." Support for this amendment can be found, for example, in the specification at Figures 1 and 5, and page 10, line 29 through page 12, line 29.

In contrast, the Examiner has not established that the "ion implanted isolation moat 12" purported by the Examiner to be disclosed in *Hesselink* is configured and arranged as required by amended claim 13. By way of example, a brief initial review of *Hesselink* (see Figures 1, 4 and 5) suggests that the aforementioned "ion implanted isolation moat 12" does not extend into any layer of the disclosed device, much less "... into the epitaxial layer ..." as claim 13 now requires. Applicant thus respectfully submits that the rejection of claim 13, as well as the rejection of corresponding dependent claims 14, 20 and 22, should accordingly be withdrawn.

III. Rejection of Claims 4-9, 11-12, 15-19 and 21 under 35 U.S.C. § 103(a)

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 4-9, 11-12, 15-19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Hesselink* in view of US 6,830,940 to Wasserbauer et al. ("*Wasserbauer*"). In view of the cancellation herein of claims 1-12, Applicant submits that the rejection of claims 4-9 and 11-12 has been rendered moot and should accordingly be withdrawn. As to the remaining claims 15-19 and 21, Applicant disagrees with the Examiner and submits that for at least the reasons outlined herein, the rejection of those claims should be withdrawn.

Particularly, by virtue of their dependence from claim 13, claims 15-19 and 21 each require, among other things, "... where formation of the optoelectronic structure comprises depositing an epitaxial layer on a substrate [and] ... said isolation moat extends into the epitaxial layer." However, the Examiner has not established that *Hesselink* or *Wasserbauer*, either alone or in combination with each other, teach or suggest the aforementioned limitation in combination with the other limitations of the rejected claims. Thus, even if *Hesselink* and *Wasserbauer* are combined in the allegedly obvious fashion advanced by the Examiner, the resulting combinations nonetheless fail to include all the limitations of claims 15-19 and 21. Applicant thus respectfully submits that the Examiner has failed to establish a *prima facie* case of

obviousness with respect to those claims, and the rejection of dependent claims 15-19 and 21 should accordingly be withdrawn.

IV. Rejection of Claims 1-12 under 35 U.S.C. § 101

The Examiner has rejected claims 1-12 under 35 U.S.C. § 101 as “claiming the same invention as that of claims 1-12 of prior U.S. Patent No. 6,724,798.” Applicant respectfully submits that in view of the cancellation herein of claims 1-12, the rejection has been overcome and should be withdrawn.

V. New Claims 24-29

By this paper, Applicant has added new claims 24-29, each of which depends from independent claim 13. As discussed herein, claim 13 is believed to be in allowable condition and dependent claims 24-29 are likewise believed to be in allowable condition, for at least the reasons set forth herein.

VI. Correction to Attorney Docket No.

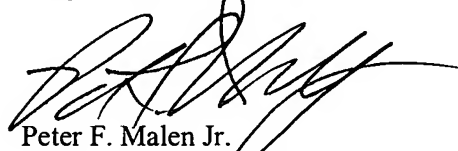
Applicant respectfully notes that the Office Action incorrectly references Attorney Docket No. “H0001589-D1 (13358.6USD1).” Pursuant to the Change of Attorney Docket Number filed in this case on July 1, 2004, the correct docket number for this case is 15436.437.7.1. Applicant thus respectfully requests that all applicable USPTO records be updated accordingly, and Applicant further requests that all further communications from the USPTO reference docket number 15436.437.7.1.

CONCLUSION

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 13-29 now pending in this application is in condition for allowance. Therefore, allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 3RD day of January, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter F. Malen Jr.', is written over the typed name.

Peter F. Malen Jr.
Attorney for Applicants
Registration No. 45,576
Customer No. 022913
Telephone: (801) 533-9800